

BONTEL.016T
Serial Number: 87/270,661
Mark: BEYOND

The following amendments and remarks are in response to the Office Action mailed March 21, 2017.

AMENDMENTS

I. Identification of Services

The Examining Attorney requested that Applicant clarify the services listed in the application. Although Applicant respectfully submits that the wording was acceptable as written, in an effort to move the subject application forward in examination, Applicant hereby submits the following amendments as suggested by the Examining Attorney and consistent with the Acceptable Goods and Services Manual:

Class 35:

Procurement, namely, purchasing tickets to entertainment events for others; Advertising services, namely, promoting and marketing the goods and services of others in the field of travel and temporary accommodations

Class 39:

Travel agency services, **namely, making reservations and bookings for transportation and tours**; Arranging and coordinating travel arrangements for individuals and groups; Chauffeur driven car hire services; Chauffeur services; Limousine services; Organization of travel; Providing a web site featuring travel information

Class 41:

Arranging for ticket reservations for shows and other entertainment events; Booking of seats for shows and booking of theatre tickets; Admission ticket reservation and booking services for night clubs and night club events; **Entertainment services, namely, arranging for ticket reservations for amusement park attractions**

Class 43:

Travel agency services, namely, making reservations and bookings for temporary lodging; Hotel accommodation services; Making hotel reservations for others; Making reservations and bookings for others for accommodations and meals at hotels and resorts; Providing a website featuring information in the field of hotels and temporary accommodations for travelers; Agency services for the reservation of temporary accommodation; Reservation of hotel rooms for travelers

Class 45:

Concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs.

REMARKS

I. Prior-Filed Application—Advisory

The Examining Attorney has cited pending U.S. Application BEYOND (Serial No. 87/244068) as a prior-filed pending application that may present a bar to registration of Applicant's mark. Applicant notes that a response was not timely filed in response to the office action issued for the BEYOND application. Thus, this issue is moot.

RESPONSE

I. Likelihood of Confusion Refusal

Applicant's application for BEYOND ("Applicant's Mark") was initially refused registration under 15 U.S.C. § 1052(d) on the ground that there is purportedly a likelihood of confusion with the marks shown in the following registrations:

- 3994297 - & BEYOND: travel arrangement and organization services and arranging for food, drink, and temporary accommodations
- 3938506 - & BEYOND: travel arrangement and organization services and providing temporary accommodations
- 4709112 – BEYOND BOUTIQUE: resort lodging services
- 4370589 – BEYOND EXPECTATIONS: hotel, resort, lodging, and restaurant services
- 4844680 – BEYOND STUDENT TRAVEL: arranging excursions and travel tours, booking tickets, chartering transportation, coordinating travel arrangements, making reservations and bookings, organizing travel, and travel agency services
- 3837465 – BEYOND. TRANSPORTATION.: chauffeur services and limousine services
- 2563765 – TRAVEL BEYOND: travel agency services and travel information services
- 4461819 – TRAVEL BEYOND: travel agency services and travel information services
- 3507138 – TRAVEL BEYOND YOUR EXPECTATIONS: travel agency services
- 4130908 – WORLD BEYOND TOURS: travel agency services and providing a website featuring information on travel
- 4912230 – ALASKA BEYOND: air transportation services
- 4995246 – BEYONDTOURISM.NET: advertising services for tourist and cultural activities, travel agency services, transporting persons
- 4174141 – Q QUINTESS BEYOND: organization of excursions, tours, and travel, providing travel information online
- 4124711 – QUINTESS BEYOND: organization of excursions, tours, and travel, providing travel information online
- 4335293 – BEYOND ALL INCLUSIVE, BEYOND ALL COMPARE: arranging excursions, transportation of travelers, booking air travel, hotel accommodation services, travel agency services, providing information about hotel resort accommodations online

- 3033626 – BEYOND TIMES SQUARE: making reservations and bookings for transportation, providing travel information
- 2954702 – BEYOND YOUR DREAMS. WITHIN YOUR REACH.: travel agency services, travel information services, travel booking services, arranging tours
- 2236618 – BEYOND BOUNDARIES: tour guide services
- 2262375 – BEYOND BOUNDARIES EXPEDITIONS: tour guide services
- 1361051 – HONGKONG AND BEYOND: arranging and conducting travel tours

(Collectively, the “Cited Marks”).

For the reasons set forth below, Applicant respectfully submits that registration of Applicant’s Mark will not cause a likelihood of confusion with the Cited Marks.

A. Standard

The controlling standard for determining a likelihood of confusion is whether the purchasing public would mistakenly assume that the Applicant’s services originate with, are sponsored by, or are in some way associated with the services offered in connection with the Cited Marks. *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 U.S.P.Q. 2d 1584, 1594 (T.T.A.B. 2011). T.M.E.P. §1207.01 sets forth numerous factors that are relevant in making a determination of likelihood of confusion, including (1) the dissimilarity and nature of the goods and services as described in the application or registration; (2) the dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (3) the number and nature of similar marks in use on similar goods; (4) the conditions under which and buyers to whom sales are made, i.e., careful, sophisticated purchasing; (5) the similarity or dissimilarity of likely-to-continue trade channels, and (6) any other established fact probative of the effect of use. *See* T.M.E.P. §1207.01 (*citing In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) (“*DuPont*”)).

The Examining Attorney “bears the burden of making out a persuasive case for finding that confusion among consumers or users of products or services is not merely a theoretical possibility but is likely.” *In re Med. Cent. Online, Inc.*, Serial No. 76/138,824 (T.T.A.B. Oct. 22, 2003) (non-precedential). Argument and conclusory assertions do not suffice to establish a likelihood of confusion. *In re Consulting Servs. Int’l Inc.*, Serial No. 76/376,622 (T.T.A.B. Oct. 3, 2003). The determination of the relatedness of the goods and services is based on the evidence provided by the applicant and the examining attorney. T.M.E.P. § 1207.01(a)(ii)(A). Even when the respective marks are identical, the record must still evidence at least a “viable relationship” between the goods and/or services identified to support a finding of likelihood of confusion. *In re Concordia Int’l Forwarding Corp.*, 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983). If “the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, **even if the marks are identical**, confusion is not likely.” T.M.E.P. § 1207.01(a)(i) (emphasis added).

B. The Number of Registered Marks that Include “BEYOND” Demonstrates that Registering Applicant’s Mark will not Lead to a Likelihood of Confusion

Third-party use of the relevant mark is “key to determining the distinctiveness” of the relevant mark and “plays a significant role in the likelihood of confusion analysis.” *Carefirst of MD., Inc. v. FirstHealth of the Carolinas, Inc.*, 77 U.S.P.Q.2d 1492, 1514 (T.T.A.B. 2005). In fact, T.M.E.P. §1207.01(d)(x) provides that “[i]f the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.”

Rather than supporting Examining Attorney’s argument that a likelihood of confusion exists, the list of twenty BEYOND-inclusive marks (together the Cited Marks) actually indicate there is peaceful coexistence between numerous live registrations covering entertainment, advertisement, travel, and concierge services. T.M.E.P. § 1207.01(d)(iii) provides that “[t]hird-party registrations may be relevant to show that ... the public will look to other elements to distinguish the source of the goods or services.” Thus, by issuing the twenty Cited Marks the PTO acknowledges that even slight variations in the goods or services is sufficient to preclude a likelihood of confusion in the relevant field.

In *In re Hamilton Bank*, the Board reversed the refusal to register under Section 2(d) based on the fact that the federal register showed numerous registrations for banking services incorporating the word “key.” 222 U.S.P.Q 174, 177 (T.T.A.B. 1984). In reversing the refusal, the Board held that “the applicant’s mark is no more likely to cause confusion with the five cited registered marks than the five cited marks are likely to cause confusion with the fifteen other registered marks which contain the term ‘KEY.’” *Id.* Likewise, Applicant’s Mark is no more likely to cause confusion with the Cited Marks than the Cited Marks are likely to cause confusion with each other.

As explained in *Plus Prods. v. Star-Kist Foods, Inc.*, 220 U.S.P.Q. 541, 544 (T.T.A.B. 1983), third-party registrations “are competent and admissible to show that the Office has over the years registered numerous marks containing ‘PLUS.’” Likewise, given the ubiquitous use of the word BEYOND on many different kinds of entertainment, advertisement, travel, and concierge services, the term BEYOND in the cited registrations is only entitled to a narrow scope of protection for these services.

Moreover, the very existence of a multiplicity of similar marks decreases the likelihood of confusion between Applicant’s Mark and the Cited Marks. *See Loctite Corp. v. Tubbs Cordage Co.*, 175 U.S.P.Q. 663 (T.T.A.B. 1972); *In re Shoe Corp. of America v. The Juvenile Shoe Corp. of America*, 121 U.S.P.Q. 510, 512-13. Thus, the fact that the Cited Marks have peacefully coexisted further indicates that such marks are not entitled to broad protection.

The Cited Marks were examined and approved by the PTO which determined that the Cited Marks avoid a likelihood of confusion. This is not surprising given the differences in the identified services. Moreover, Applicant notes that a quick Google search revealed numerous related uses of the term BEYOND. In fact, over one trillion hits were revealed in a Google search for the term BEYOND, over two hundred and ninety-four million hits were revealed in a

Google search for the terms “BEYOND” and “travel”, over ten million hits were revealed in a Google search for the terms “BEYOND” and “entertainment”, over forty-nine million hits were revealed in a Google search for the terms “BEYOND” and “advertising”, and over three million hits were revealed in a Google search for the terms “BEYOND” and “concierge. See **Exhibit A**. Consumers are able to distinguish the source of these services because they are accustomed to seeing the term BEYOND applied to different entertainment, advertisement, travel, and concierge services.

In light of the previous stance of the PTO and the myriad uses of the term “BEYOND” in the Cited Marks, the outstanding objection is improper. As the Board has stated that the PTO should avoid inconsistent practices, Applicant respectfully submits that it should not be singled out and subjected to inconsistent treatment in this case. See, e.g., *In re Women’s Publishing Co., Inc.*, 23 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1992). Instead, the likelihood of confusion objections should be removed given the crowded nature of the term “BEYOND” for entertainment, advertisement, travel, and concierge services.

CONCLUSION

In light of the information and arguments set forth above, Applicant respectfully submits that the application is now in condition to be passed to publication. If the Examining Attorney has any further questions or comments, the Examining Attorney is requested to contact the undersigned at the number below.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP
Vicki Y. Nee
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EXHIBIT A



BEYOND



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Network: Freeform

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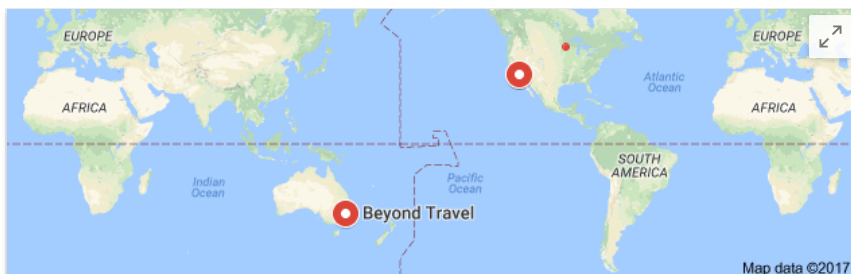
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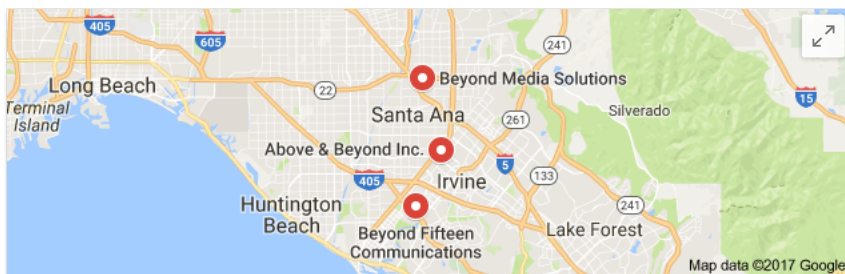
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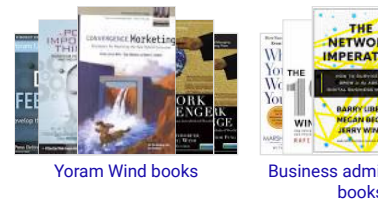
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